

### **Remarks and Arguments**

Applicants have carefully considered the Office Action dated November 14, 2006 and the references cited therein. Applicants respectfully request reexamination and reconsideration of the application.

Claim 14 is rejected as being directed to non-statutory subject matter. In response, Applicants have amended the preamble of claim 14 to remove all occurrences of the term "transmission". In addition, Applicants again respectfully request that the Examiner hold the rejection under 35 U.S.C. 101 in abeyance until a ruling in *In re Petrus ACM Nuijten*, CAFC docket No. 06-1371, U.S. Patent Application Serial No. 09/211,928, regarding the patentability of electrical signals and data embedded therein, oral arguments of which were heard on February 5, 2007.

Claims 1-2, 3-12, and 13-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leonard et al., U.S. Publication No. 2002/0046109, hereinafter Leonard, already of record, in view of Murren et al., U.S. Publication No. 2004/0205525, hereinafter Murren.

Applicants respectfully traverse the rejection of claims 1-20 under 35 U.S.C. §103(a) on the grounds that the Examiner has failed to create a *prima facie* case of obviousness. In accordance with MPEP §2143.03, to establish a *prima facie* case of obviousness 1) the prior art reference (or references when combined) must teach or suggest *all* of the claim limitations. In setting forth the rejection, the Examiner has admitted that Leonard fails to teach limitations of inserting executable instructions into said document at the location of said custom tag if said custom tag is present; executing said instructions; or rendering said document on a display device. Instead, the Examiner is relying on Murren to disclose such teachings. However, after reviewing Murren, including the sections and figures cited by Examiner, Applicants respectfully disagree with Examiner's conclusion.

Murren discloses transmission of the completed template to a client (Murren, paragraphs 53-64). In the present invention, executable code is inserted and executed at the receiving computer system, as recited in the claims, not the supplying computer as disclosed in both of the cited references. Even if Murren discloses the subject matter as alleged, which Applicants are not hereby conceding, the combined teachings of

Leonard and Murren would still not disclose, teach or suggest the subject matter as currently claimed. Specifically, the preamble of claim 1 recites "A method operating *on a client computer* for loading a markup language document" (claim 1, lines 1- 2; *emphasis added*). The preamble of apparatus claim 12 recites "An apparatus *for receiving a markup language document ... over a network*" (claim 12, lines 1- 2; *emphasis added*). The Federal Circuit has routinely held that if the claim preamble, when read in the context of the entire claim, recites the limitations of the claim, or, if the claim preamble is "necessary to give life, meaning and validity" to the claim, then the claim preamble should be construed as if in the balance of the claim. Pitney Bowes, Inc. v. Hewlett-Packard Co. , 182 F. 3d 1298, 51 USPQ 2d 1161 (Fed. Cir. 1999).

Method claim 6 even more specifically recites "providing said document *to said receiving computer over said network*" and "said document containing conventional tags and at least one custom tag, said custom tag associated *with machine-executable instructions resident on a receiving computer* in communication with said network; *said receiving computer identifying said custom tag and inserting said machine-executable instructions into said document at a location associated with said custom tag*" (claim 6, lines 3-9; *emphasis added*). Claim 14 also specifically recites "said data signal *for conveyance over a network to a receiving computer*" and "machine-readable executable instructions for parsing a conventional tag by a browser operating *on said receiving computer*" and "functional instructions for performing an operation on said receiving computer" (claim 14, lines 2-5 and 11-12 ; *emphasis added*). Claim 17 has also been amended to highlight (claim 17, lines 2, 5, 8 and 11-12).

As noted in the subject specification, an advantage of having the executable code inserted at the receiving computer for execution and display thereof is to reduce the complexity of software executable instructions on servers and to reduce the costs and complexities associated with operating servers on the Internet or other networks (Serial Number 10/76 1,139, page 2, line 17 through page 3, line 5). The references cited by the Examiner are typical of the problematic prior art discussed in the Background of the Invention section of the subject application.

In light of the foregoing, Applicants respectfully assert that the Examiner has not shown where the combined teachings of Leonard and Murren teach, disclose or

suggest *inserting* or *executing* machine-executable instructions into a document at the receiving system. Accordingly, Applicants respectfully assert that claims 1, 6, 12, 14 and 17, as well as their respective dependants claims, patently distinguish over the teachings of Leonard and Murren, whether considered alone or in combination with each other or any other reference of record.

Applicant believes the claims are in allowable condition. A notice of allowance for this application is solicited earnestly. If the Examiner has any further questions regarding this amendment, he/she is invited to call Applicant's attorney at the number listed below. The Examiner is hereby authorized to charge any fees or credit any balances under 37 CFR §1.17, and 1.16 to Deposit Account No. DA-12-2158.

Respectfully submitted,

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